

Remarks/Arguments

Status of the Application

In the present response, claims 1-5 and 7-19 have been amended so that claims 1-5 and 7-19 are pending.

Claim 1 has been amended to comport with the breadth of claim 3. Support for these amendments can be found, for example, in claim 3 as filed and at page 3, lines 1-7.

Claims 2 and 3 have been amended to accommodate the amendments to claim 1. Support for these amendments can be found, for example, in claims 2 and 3 as filed and Examples 1-5.

Claims 2-5, 7-10, and 12-19 have been amended to expressly recite, "or pharmaceutically acceptable salts thereof, or diastereomers, enantiomers, or mixtures thereof". Support for these amendments can be found, for example, at page 9, lines 14-21 and page 9, line 31 to page 10, line 14.

Claim 11 has been amended to agree with claim 1. Support for these amendments can be found, for example, in claims 3 and 11 as filed, at page 3, lines 1-7, and at page 17, line 1 to page 18, line 1.

Any amendments herein have been made without prejudice to Applicants' right to prosecute any cancelled subject matter in a timely filed continuation application.

No new matter is added.

Rejections under 35 U.S.C. §112, first paragraph

Claims 1-2, 7-11, and 13-14 stand rejected under 35 U.S.C. 112, first paragraph, "because the specification, while being enabling for furan, thiophene, pyrrole, thiazole, piperidine, and pyridine, does not reasonably provide enablement for the broader scope in 1 claim 1 [sic] and claims dependent thereon." See, Non-final Office Action mailed June 2, 2008 (hereinafter "Office Action") at page 2.

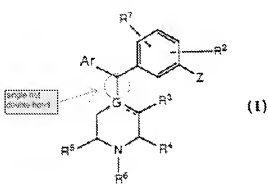
Applicants respectfully assert the amendments provided herewith have rendered this rejection moot. Accordingly, Applicants respectfully request the Office to withdraw this rejection.

Rejections Under 35 U.S.C. § 103(a)

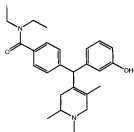
Claims 1-5 and 7-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Delorme et. al. (U.S. Pat. No. 6,187,792 or WO 98/28275). Office Action, page 5. The Office asserts Chang et al. (WO 93/15062) and Delorme et al. "both teach diphenyl piperidinylidene methyl compounds corresponding to those recited in the claims for use in treating pain." *Id.* at page 6. To support its assertion, the Office directs Applicants' attention to "page 10 formula (II) where G is carbon and page 118 example 52, and page 37 example 12."

Applicants respectfully assert the Office has failed to establish a *prima facie* case of obviousness because Chang et al. or Delorme et al. (either alone or in combination) do not provide any reason or motivation to make the compounds of the presently claimed invention. Indeed, the Office has failed to identify why a person of ordinary skill in the art would have been led to first select and then modify example 52 and/or example 12 in the manner need to arrive at Applicants' claimed invention.

Turning first to Chang et al., Applicants assert it does **not** teach diphenyl piperidinylidene methyl compounds as asserted by the Office. Applicants direct the Office's attention to the following marked-up diagram of Chang et al.'s formula I:



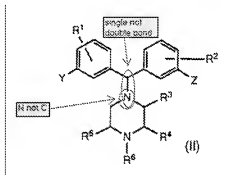
which points out Chang et al.'s compounds contain a single bond where Applicants' claimed compounds contain a double bond. Additionally, Chang et al.'s Example 52 compound, which has the following structure:



, contains not only a single rather than double bond but a meta-

substituted hydroxyl group rather than the $-NR^5S(=O)_2R^4$ group of the presently claimed invention.

Moreover, formula II on page 10 of Chang et al. does not, as asserted by the Office, contain a carbon as the G group of formula I. Rather, formula II on page 10 of Chang et al. contains not only a nitrogen as the formula I G group but also a single rather than double bond. Applicants direct the Office's attention to the following marked-



up version of Chang et al.'s page 10 formula II:

With respect to Delorme et al., Applicants assert example 12 does not contain a meta substituted $-NR^5S(=O)_2R^4$ group in accordance with the presently claimed invention. Rather, Example 12 contains a para-substituted chlorine group. Moreover, none of the exemplified compounds of Delorme et al. contain as either the A or B group of their formula I a phenyl meta-substituted with an $-NR^5S(=O)_2R^4$ group.

In view of the aforementioned differences of the presently claimed invention over the compounds of Chang et al. and Delorme et al. and the absence of any reason or motivation for a person of ordinary skill in the art to first select and then modify any of the exemplified compounds of either Chang et al. and/or Delorme et al. in the manner needed to arrive at the compounds of the presently claimed invention, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request the Office to withdraw this rejection.

Summary

In view of the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance and respectfully solicit same. In order to expedite disposition of this case, the Office is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues.

Although Applicants believe no fees other than those accompanying this response are due, the Commissioner is hereby authorized to charge any deficiency in fees or credit any overpayment to deposit account No. 26-0166, referencing Attorney Docket No. 100953-1P US.

Respectfully submitted,

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